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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/727,306

Filing Date: December 03, 2003

Appellant(s): WILSON, DOUGLAS B.

Wayne M. Kennard
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed October 31, 2006 and September 10, 2007 appealing from the Office action mailed March 30, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal: related appeal of copending Application No. 10720821 as listed by Appellant.

(3) Status of claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments after Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of claimed subject matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of rejection to be reviewed on appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal in the brief is substantially correct. The changes are as follows:

- (A) Claims 14-19, 24/14, and 27 are rejected under 35 USC 112, second paragraph, for indefiniteness;
- (B) Claims 14-17, 19/17, 24/14, and 27, as best understood, are rejected under 35 USC 102(b) as being anticipated by Van Arsdel;
- (C) Claims 14-17, 19/17, 24/14, and 27, as best understood, are rejected under 35 USC 102(b) as being anticipated by Anson;
- (D) Claims 14, 18, and 19/18, as best understood, are rejected under 35 USC 102(b) as being anticipated by Laubach; and

(E) Claims 14-19, 24/14, and 27, as best understood, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-28 of copending Application No. 10720821 (hereinafter "Appl.'821").

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence relied upon in the rejection of claims under appeal.

2,118,540	Van Arsdel	May 24, 1938
2,134,020	Anson	October 25, 1938
1,575,848	Laubach	March 9, 1926
Appl.'821	Wilson	Filed November 24, 2003

(9) Grounds of rejection

The following grounds of rejection are applicable to the appealed claims:

(A) Claims 14-19, 24/14, and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "rigid," "semi-rigid," "flexible," or "non-deformable" in claims 14 and 27 is a relative term, which renders the claim indefinite. The term "rigid," "semi-rigid," "flexible," or "non-deformable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For example, it is unclear what range of Rockwell hardness of the material of the second section is required in order to be considered as being

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“rigid,” “semi-rigid,” “flexible,” or “non-deformable.” See *Fredman v. Harris-Hub Co., Inc.*, 163 USPQ 397 (DC N Ill 1969) (“Flexibility” and “rigidity” are relative terms, particularly since virtually any thing will flex if enough pressure is applied to it).

(B) Claims 14-17, 19/17, 24/14, and 27, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Van Arsdel (US Patent No. 2,118,540).

Regarding claim 14, Van Arsdel teaches a fatigue relieving/preventing apparatus associated with a steering wheel 3 for controlling a vehicle, comprising:

a first section 4 (i.e., a horizontal section) that connects to a peripheral portion of the steering wheel 3; and

a rigid, semi-rigid or flexible, or non-deformable second section 2 that connects to, and extends from the first section 4 at the peripheral portion of the steering wheel 3, the second section 2 extends from the first section 4 outward at an angle (see angle α in Figs. 3 and 5 of Attachment 1) to a plane (Att. 1) across a front face of the steering wheel 3, the second section 2 for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 2 is less than the pressure for deforming the second section 2 out of interference with the vehicular operator's ability to operate the steering wheel 3, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 3 when pressure from the portion of the vehicular operator's body on the second section 2 is equal to or greater than the pressure for deforming the second section 2 out of interference with the vehicular operator's ability to operate the steering wheel 3.

Regarding claim 15, the steering wheel 3 includes a steering wheel 3 for controlling at least a nautical vessel, aircraft, or ground transportation vehicle.

Regarding claim 16, the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

Regarding claim 17, the first section 4 extends a length of a predetermined peripheral portion of the steering wheel 3.

Regarding claim 19/17, the first section 4 is deformable. Note that virtually any thing will be deformed if enough pressure is applied to it. See “flexibility” in *Fredman v. Harris-Hub Co., Inc., supra*.

Regarding claim 24/14, each first section 4 is formed integral with the steering wheel 3. It is well settled that the term “integral” is not restricted to a one-piece article. The term “integral” is sufficiently broad to embrace constructions united by such means as fastening and welding. See *In re Hotte*, 177 USPQ 326 (CCPA); *In re Clark*, 102 USPQ 241 (CCPA); *In re Dike*, 157 USPQ 581 (CCPA); *In re Kohno*, 157 USPQ 275 (CCPA); and *In re Morris*, 43 USPQ2d 1753, 1757 (CAFC 1997).

Regarding claim 27, the first section 4 is flexible, rigid, or semi-rigid, or non-deformable. See “flexibility” in *Fredman v. Harris-Hub Co., Inc., supra*.

(C) Claims 14-17, 19/17, 24/14, and 27, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Anson (US Patent No. 2,134,020).

Regarding claim 14, Anson teaches a fatigue relieving/preventing apparatus associated with a steering wheel 10 for controlling a vehicle, comprising:

a first section 13 that connects to a peripheral portion of the steering wheel 10; and a rigid, semi-rigid or flexible, or non-deformable second section 11 that connects to, and extends from the first section 13 at the peripheral portion of the steering wheel 10, the second section 11 extends from the first section 13 outward at an angle (see angle α in Fig. 8 of

Attachment 2) to a plane (Att. 2) across a front face of the steering wheel 10, the second section 11 for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 11 is less than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 10 when pressure from the portion of the vehicular operator's body on the second section 11 is equal to or greater than the pressure for deforming the second section 11 out of interference with the vehicular operator's ability to operate the steering wheel 10.

Regarding claim 15, the steering wheel 10 includes a steering wheel 10 for controlling at least a nautical vessel, aircraft, or ground transportation vehicle.

Regarding claim 16, the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

Regarding claim 17, the first section 13 extends a length of a predetermined peripheral portion of the steering wheel 10.

Regarding claim 19/17, the first section 13 is deformable. Note that virtually any thing will be deformed if enough pressure is applied to it. See “flexible” in *Fredman v. Harris-Hub Co., Inc., supra*.

Regarding claim 24/14, each first section 13 is formed integral with the steering wheel 10. See *In re Hotte*; *In re Clark*; *In re Dike*; *In re Kohno*; and *In re Morris, supra*.

Regarding claim 27, the first section 13 is flexible, rigid, or semi-rigid, or nondeformable. See “flexible” in *Fredman v. Harris-Hub Co., Inc., supra*.

(D) Claims 14, 18, and 19/18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Laubach (US Patent No. 1,575,848).

Regarding claim 14, Laubach teaches a fatigue relieving/preventing apparatus associated with a steering wheel 1 for controlling a vehicle, comprising:

a first section 7, 8 that connects to a peripheral portion of the steering wheel 1; and a rigid, semi-rigid or flexible, or non-deformable second section 10 that connects to, and extends from the first section 7, 8 at the peripheral portion of the steering wheel 1, the second section 10 extends from the first section 7, 8 outward at an angle (see angle α in Fig. 2 of Attachment 3) to a plane (Att. 3) across a front face (Att. 3) of the steering wheel 1, the second section 10 for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section 10 is less than the pressure for deforming the second section 10 out of interference with the vehicular operator's ability to operate the steering wheel 1, and deforming out of interference with the vehicular operator's ability to operate the steering wheel 1 when pressure from the portion of the vehicular operator's body on the second section 10 is equal to or greater than the pressure for deforming the second section 10 out of interference with the vehicular operator's ability to operate the steering wheel 1.

Regarding claim 18, the second section 10 includes at least two second sections (Fig. 1) that each connect to the first section 7, 8 at separate locations.

Regarding claim 19/18, the first section 7, 8 is deformable. Note that virtually any thing will be deformed if enough pressure is applied to it. See "flexible" in *Fredman v. Harris-Hub Co., Inc., supra*.

- (E) Claims 14-19, 24/14, and 27, as best understood, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-28 of copending Application No. 10720821 (Appl.'821).

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14-19, 24/14, and 27 of this application and claims 20-28 of Appl.'821 substantially claim common structures such as a first section and a second section connected to the first section. To the extent that claims 14-19, 24/14, and 27 in this application call for the second section being rigid, semi-rigid or flexible, or *non-deformable*, meanwhile, claims 20-28 in Appl.'821 call for the second section being *deformable*, however, the terms rigid, semi-rigid, flexible, non-deformable, and deformable are relative terms. In fact, when the second section is rigid, semi-rigid, or flexible, it will be deformed if enough pressure is applied to it. Alternatively, when the second section is deformable, it inherently is flexible. See *Fredman v. Harris-Hub Co., Inc.*, *supra*. On the other hand, it is well settled that selection of known material suitable for its intended purpose would have been obvious. *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the material of the second section claimed in claims 14-19, 24/14, and 27 of this application such that it is deformable as claimed in claims 20-28 of Appl.'821 in order support a portion of the vehicular operator's body as taught or suggested by common knowledge in the art. *In re Leshin*, *supra*.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

(10) Response to argument

A. General

The Examiner respectfully submits:

As noted in MPEP 2111, during patent examination, *claims are given their broadest reasonable interpretation consistent with the specification*. It is proper to use the specification to interpret what the Appellant meant by a word or phrase recited in the claim. However, *it is not proper to read limitations appearing in the specification into the claim when these limitations are not recited in the claim*. See *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994); and *Intervet America Inc. v. Kee-Vet Lab. Inc.*, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). (Emphasis added).

B. The Claims are Indefinite

The rejection under 35 USC 112, second paragraph, in this case is proper because the reason is simply that during patent prosecution, the claims can be amended to remove the ambiguities. *In re Zletz*, 13 USPQ2d 1320, 1322 (CAFC 1989). In fact, our reviewing Court in *Zletz* emphasized:

An essential purpose of patent examination is to fashion claims that are *precise, clear, correct, and unambiguous*. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.

Thus, the inquiry during examination is patentability of the invention as “the applicant regards” it, and if the claims do not “particularly point out and distinctly claim”, in the words of section 112, that which examination shows the applicant is entitled to claim as his invention, *the appropriate PTO action is to reject the claims for that reason*. (Emphasis added).

Regarding Appellant’s reliance on extrinsic evidence, such-as, *Ninth New Collegiate Dictionary*, the Examiner respectfully submits that the specification is the single best guide to the meaning of a claim term. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 [75 USPQ2d 1321](Fed. Cir. 2005)(*en banc*). See also, e.g., the meaning of the term "adjustable" in *Curtiss-Wright Flow Control Corp. v. Velan Inc.*, 77 USPQ2d 1988 (Fed. Cir. 2006). Since Appellant’s specification

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does not provide a guidance as to, *inter alia*, (a) what type of material(s) is(are) considered to be “rigid, semi-rigid, or flexible, or non-deformable”; and (b) what objective test(s) is(are) required in order to determine whether a material is “rigid, semi-rigid, or flexible, or non-deformable.” Thus, Appellant’s claims are *unclear and/or ambiguous*.

C. Van Arsdel

At the outset, Appellant’s arguments are not based on the limitations appearing in the claims. *In re Self*, 213 USPQ 1, 5 (CCPA 1982). In fact, Appellant’s claim 14 recites “*a rigid, semi-rigid or flexible, or non-deformable second section* that connects to, and extends from the first section outward at an angle to a plane across a front face to the steering wheel.” It is clear from claim 14 that it requires the second section of the handgrip, *not* the handgrip *per se*, extends from the first section outward at an angle to the plane across the face of the steering wheel. Therefore, Appellant’s contention that the grip rest of Van Arsdel is in a plane parallel with the one across the face of the steering wheel on page 8 of the brief is immaterial to the patentability of the claim. The issue is not whether Arsdel’s grip rest is disposed at an angle relative to the plane across the face of the steering wheel. Rather, the issue is whether Arsdel teaches the second section that connects to and extends from the first section outward at an angle relative to the plane across the face of the steering wheel.

In the case at hand, on page 1, right column, lines 13-28, Arsdel describes: “[t]he grip rest 2 is *concave* longitudinally and about half of the rest extends over and part way across the steering wheel rim 3 in a manner to slope downwardly and inwardly of the rim. The outer edge 4 of the side, and 5 of the rear end of the *concave*, located above the rim, *extends up into a marginal flange* to be contacted by the inside of the ball of the thumb or by the bottom of the

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hand, depending upon which part of the hand is seated to rest." See also Arsdel's claims 1 and 2. Arsdel's concave upward section 2 extends from the first section 4 outward at an angle α to the plane across the face of the steering wheel as seen in Figs. 3 and 8 of Attachment 1 of the final action. Therefore, Arsdel's concave upward section 2 in Fig. 3 of Arsdel "reads on" Appellant's claimed second section.

In addition, Appellant's contention that "[o]nce the grip-rest of Arsdel's handgrip is in place, it is *fixed*, and does not move" is unsupported by substantial evidence in the record. Indeed, on page 1, right column, line 49 through line 2, left column, page 2, Arsdel expressly describes:

My improved grip-rest may be formed integrally with the rim of the steering wheel as shown in Fig. 8, but I prefer to make it *removable* as an attachment for any make of car and also to make it *adjustable* to suit the requirements or fancy of the driver. (Emphasis added).

Particularly, Appellant's contention is in direct conflict with Arsdel's description on page 2, left column, lines 28-32:

The grip rest *may be shifted* along the length of the rim, or vertically around it by reversing the screw sufficiently to permit *change of the rest to the new position*, where it will be held again by tightening up on the screw. (Emphasis added).

Simply put, Arsdel explicitly teaches that the driver may loosen the screw 14 in Fig. 6 so that it is *deformable* in order that the driver can put extensive pressure on it and *it will move* for steering the automobile.

The support in the description of Arsdel for the statement that the second section will deform out of the interference with the operation of the steering wheel is found on page 2, left column, lines 28-32. By loosening or reversing the screw 14 sufficiently to permit Arsdel's

second section 2 shifted vertically around the rim 3, the second section can be at the new position wherein the second section does not interfere with the operation of the steering wheel to suit the requirements or fancy of the driver.

D. Anson

The thrust of Appellant's arguments is that Anson is missing at least the deforming element of claim 20. See first paragraph on page 12 of the brief. However, claim 20 is withdrawal claim. Therefore, the Examiner assumes that Appellant intended to mean claim 14.

The instant assertion is likewise unsupported by substantial evidence in the record. In fact, Anson's grip is made of flexible or semi-rigid material, therefore, Anson's grip is deformable or deflectable out of interference with the vehicular operator's ability to operate the steering wheel, *i.e.*, out of the normal position. See page 2, right column, and lines 25-40, quoted below:

In the modification illustrated in Figs. 4 and 6, neck 12 is constructed of a rubber composition having the same desired characteristics of pliability and semi-rigidity described in connection with the form illustrated in Figs. 1 and 2 and described above. The hand grip portion 11, however, may be made of solid material such as metal, and is detachably connected to neck 12. While this modification does not possess the degree of hand gripping comfort inherent in the principal modification, nevertheless, by virtue of the pliability and semi-rigidity of the neck portion; this type of attachment will also provide the advantages of *ready deflection from the normal position* while affording positive control of the wheel movements. (Emphasis added).

In addition, on page 1, left column, line 48 through line 32, right column, Anson expressly describes: "a means for attachment to the steering wheel, whereby *the device may be readily attached to, or removed from, the wheel, and which may be quickly and easily shifted to*

various positions on the wheel as dictated by the degree of driving comfort desired."

Particularly, on page 2, left column, lines 62-72, Anson teaches:

At the same time, if it becomes desirable to move the attachment to a different position on the wheel rim, a slight movement of the grip portion toward the wheel rim will loosen the contact of strap 13 therewith, and the attachment can then be easily shifted to some other position on the wheel. Similarly, *the attachment may be rotated about the wheel rim* from its normal pendent position to *a position within the periphery of the wheel* when it becomes desirable to dispense with its use in operating the wheel. (Emphasis added).

As evidenced by the above quotations, Anson explicitly states that the driver may rotate Anson's attachment/handgrip about the wheel rim 10 to a position within the periphery of the wheel, *i.e.*, to a position shown in Appellant's Fig. 4 when the driver so desires. Anson's description reveals that Anson-type-attachment is operated in a similar manner to what is claimed in claim 14. As such, a person of ordinary skill in the art would find that there is a teaching in Anson in which the hand/other body part is supported by Anson attachment as claimed.

Further, since Anson's *attachment may be rotated about the wheel rim* from its normal pendent position to *a position within the periphery of the wheel* when it becomes desirable to dispense with its use in operating the wheel, Anson's attachment is capable to be rotated outward such that the second section 11 is at an angle from the plane across the face of the steering wheel and out of interference with the operation of the steering wheel as claimed.

On the other hand, it is well settled that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural

limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. Inter. 1987) and MPEP 2114. Since Anson teaches all structural limitations and the functional language in the claims. Therefore, Appellant's claims 14-17, 19/17, 24/14, and 27 are anticipated by Anson as a matter of law.

E. Laubach

Appellant contended that the knobs of Laubach are rigidly connected to the steering wheel by the screws 5, thus, the knobs are meant remain in place in operation. Nevertheless, common sense teaches that the driver can unscrew Laubach's screws 5, and then screw or fasten the screws 5 at other position on the rim 6 of the steering wheel as the driver so desires. In other words, the position of Laubach's knobs is capable of being changed. As such, Laubach's knobs can inherently perform the functions recited in Appellant's claim. *In re Schreiber*, 128 F.3d 1437, 44 USPQ2d 1429 (Fed. Cir. 1997).

Appellant further asserted that the knob of Laubach does not deform out of interference with the operation of the steering wheel as set forth in claim 14. The Examiner respectfully submits that the driver can unscrew Laubach's screws 5, and then screw or fasten the screws 5 at other position on the rim 6 of the steering wheel such that the new position is out of interference with the operation of the steering wheel as the driver so desires. The operation to adjust or change the position of Laubach's handgrips is similar to the operation to adjust the handgrip of Arsdel since both Laubach and Arsdel use the screws as the fastening means. Since the position of Laubach's knobs is capable of being changed to be out of interference with the operation of the steering wheel, therefore, Appellant's claims are anticipated by Laubach. *In re Schreiber*; *Ex parte Masham*; and MPEP 2114, *supra*.

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F. Obviousness-type Double Patenting

Appellant promised on page 3 of the brief that Appellant will file a terminal disclaimer to overcome the obviousness-type double patenting rejection. Appellant's promise without consideration does not overcome the current obviousness-type double patenting.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Vinh T. Luong
Primary Examiner

Conferees on September 7, 2006:

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ATTACHMENT 1

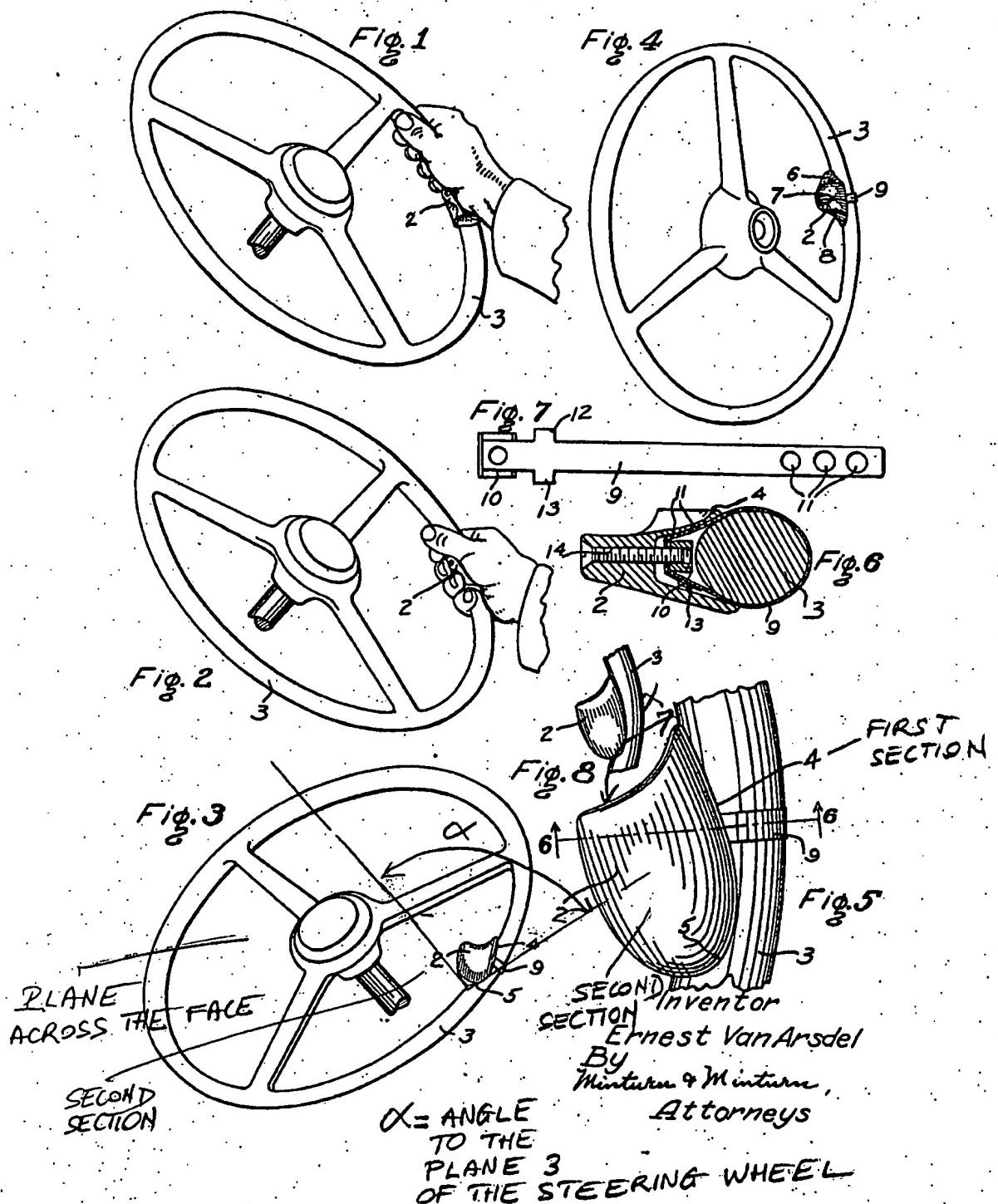
May 24, 1938.

E. VAN ARSDEL

2,118,540

AUTO STEERING WHEEL HANDGRIP

Filed May 10, 1937



ATTACHMENT 2

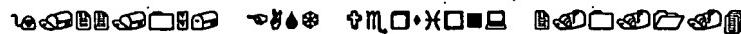
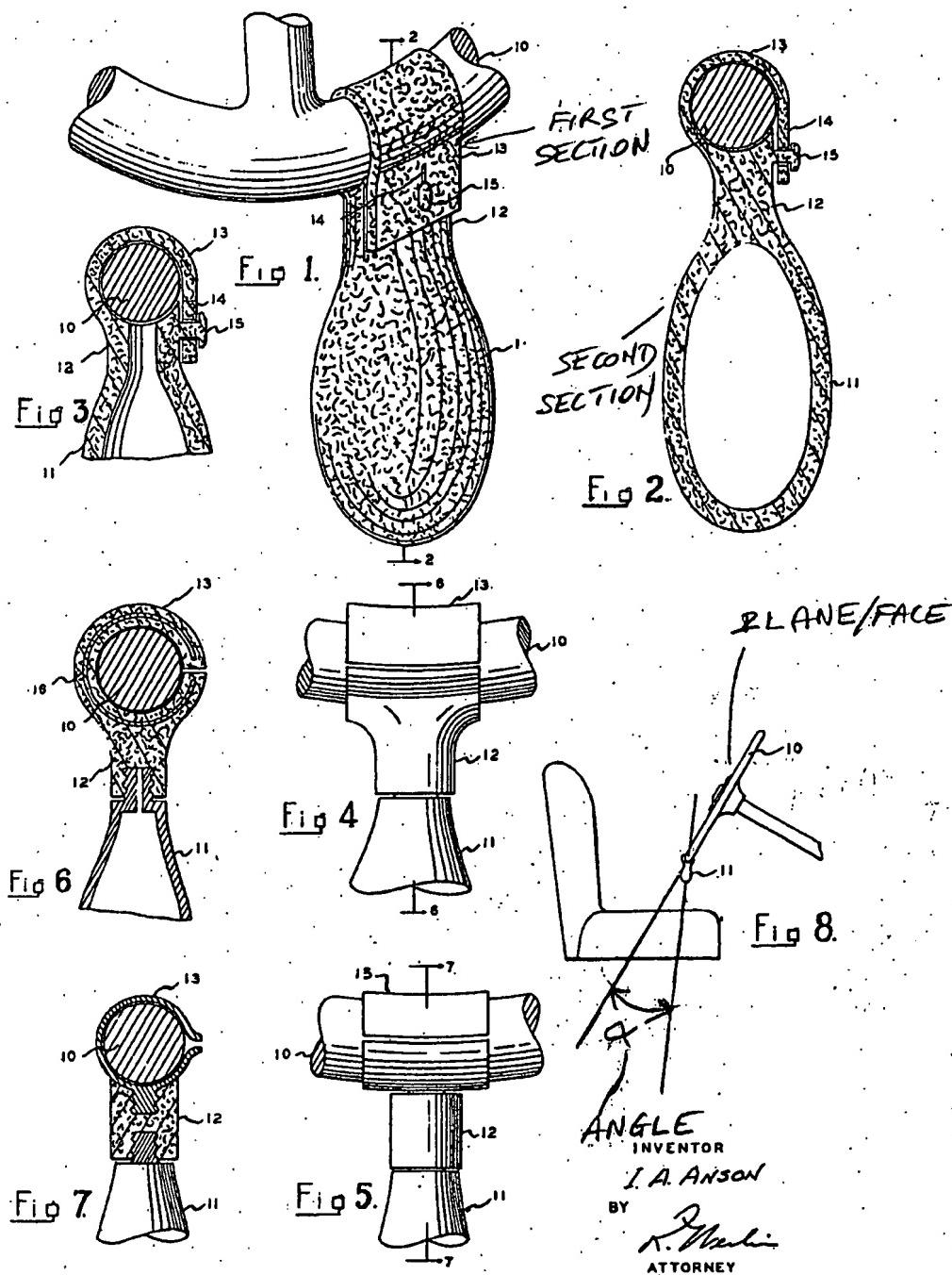
Oct. 25, 1938.

I. A. ANSON

2,134,020

STEERING WHEEL ATTACHMENT

Filed Sept. 30, 1937



ATTACHMENT 3

March 9, 1926.

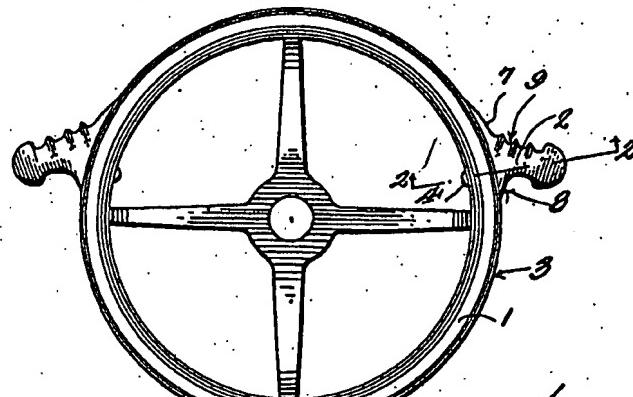
1,575,848

C. E. E. LAUBACH

STEERING WHEEL

Filed July 13, 1925

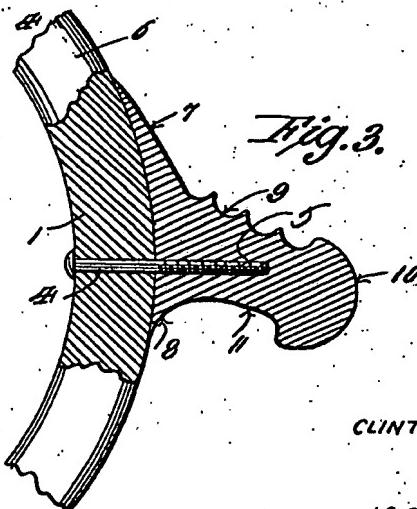
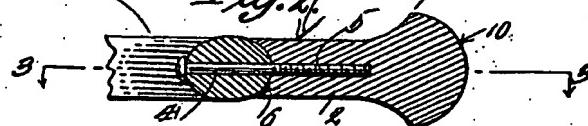
Fig. 1.



PLANE/FACE

4

Fig. 2



WITNESSES

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Attorney